UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,835	11/19/2003	Kazuhito Gassho	Q78470	3632

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 June 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 June 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *11/19/2003*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Priority

1.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on 11/19/03 has been

considered by the examiner.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 10-11 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Regarding claims 10-11 are drawn to functional descriptive material embodied on

a computer readable medium (i.e., "data structures and computer programs which

impart functionality when employed as a computer component" at MPEP 2106.IV.B(1)).

However, the program/algorithm itself merely manipulates data or an abstract idea, or

merely solves a mathematical problem without a limitation to a practical application in

the technological arts. MPEP 2106.IV.B.2(a) (Statutory Product Claims) states:

"A claim limited to a ... manufacture, which has a practical application in the

technological arts, is statutory."

In order for a claimed invention to accomplish a practical application, it must produce a "useful, concrete and tangible result" *State Street,* 149 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). Currently, the claim does not recite a practical application. In order to for the claimed product to produce a "useful, concrete and tangible" result, recitation of one or more of the following elements is suggested:

- The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).

- A physical transformations outside the computer, for example in the form of pre or post computer processing activity (MPEP 2106 IVB2(b)(i)).

- A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2(b)(ii)).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1-5, 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Goodman (US 2003/0009672).

Regarding claim 1, Goodman '672 discloses a print job management device

(print server, fig. 3A) that manages print jobs, comprising:

an input module (print console 305, page 5, paragraph [0077]) that inputs a print

job in which pieces of attribute information are dispersed in plural locations (user enter

print option data/attribute, inherent all data stored in plural locations of a memory; page

6, paragraph [0092]);

a generation module (print engine 310, page 6, paragraph [0102]) that extracts

said attribute information from said print job and generates inclusive attribute

information (an internal format, page 6, paragraph [0102]) that contains said attribute

information.

Regarding claim 2, Goodman '672 discloses a print job management device,

wherein said generation module further generates said inclusive attribute information as

data that is separable from said print job (the document processor combines the print

attributes from the administration rule with the print attributes in the response from the

DMS, page 7, paragraph [0111], fig. 4, step 435).

Regarding claim 3, Goodman '672 discloses a print job management device,

wherein said generation module further attaches said inclusive attribute information to a

header of said print job (i.e., print attributes are collected into the encrypted header as a

block denoted PRINTINFO; page 3, paragraph [0048]).

Regarding claim 4, Goodman '672 discloses a print job management device, further comprising:

a status management module (110, fig. 1) that manages said print job in coordination with a predetermined status (Mirage manages permissions using administrative rules and using a properties file, page 3, paragraph [0041]);

wherein if said print job is in a status of contents analysis (documents accessed by document management system 145, page 3, paragraph [0055], fig. 1), said generation module performs said extraction in conjunction with said analysis (the document processor extracts print information from the rule, page 6, paragraph [0108], fig. 4, step 415).

Regarding claim 5, Goodman '672 discloses a print device, comprising:

an input module (print console 305, fig. 3A) that inputs a cluster of inclusive attribute information that contains pieces of attribute information dispersed in a print job (i.e., print console 305 receives print information, it analyzes the print attributes together with data in the properties file; page 5, paragraph [0083]);

an attribute interpretation module (Mirage Server Software 155, fig. 2A) that interprets said inclusive attribute information and operates based on said inclusive attribute information (i.e., the interceptor matches the request against administration rules, which preferably include printing attributes; page 6, paragraph [0107]).

Regarding claim 8, Goodman '672 discloses a print job management method that

uses a computer to manage print jobs, comprising:

inputting a print job (client communications go through print console 305, page 5,

paragraph [0075]) in which pieces of attribute information are dispersed in plural

locations (user enter print option data/attribute, inherent all data stored in plural

locations of a memory; page 6, paragraph [0092]);

extracting said attribute information from said print job (the document processor

extracts print information from the rule, page 6, paragraph [0108], fig. 4, step 435) and

generating inclusive attribute information (an internal format, page 6, paragraph [0102])

that contains said attribute information.

Regarding claim 9, Goodman '672 discloses a method of controlling a print

device, comprising:

inputting a cluster of inclusive attribute information that contains pieces of

attribute information dispersed in a print job (i.e., print console 305 receives print

information, it analyzes the print attributes together with data in the properties file; page

5, paragraph [0083]);

interpreting said inclusive attribute information (an internal format, page 6,

paragraph [0102]) and controlling said print device (printer 135, fig. 1) to operate based

on said inclusive attribute information (i.e., the interceptor matches the request against

administration rules, which preferably include printing attributes; page 6, paragraph

[0107]).

Regarding claim 10, Goodman '672 discloses a recording medium that is recorded with a computer program for managing print jobs, comprising:

a program code (Mirage Server Software 155, fig. 2A) that inputs a print job in which pieces of attribute information are dispersed in plural locations (user enter print option data/attribute, inherent all data stored in plural locations of a memory; page 6, paragraph [0092]);

a program code (Mirage Server Software 155, fig. 2A) that extracts said attribute information from said print job (the document processor extracts print information from the rule, page 6, paragraph [0108], fig. 4, step 435) and generates inclusive attribute information (an internal format, page 6, paragraph [0102]) that contains said attribute information.

Regarding claim 11, Goodman '672 discloses a recording medium that is recorded with a computer program for controlling a print device, comprising:

a program code (Mirage Server Software 155, fig. 2A) that inputs a cluster of inclusive attribute information that contains pieces of attribute information dispersed in a print job (i.e., print console 305 receives print information, it analyzes the print attributes together with data in the properties file; page 5, paragraph [0083]);

a program code (Mirage Server Software 155, fig. 2A) that interprets said inclusive attribute information (an internal format, page 6, paragraph [0102]) and controls said print device to operate based on said inclusive attribute information (i.e.,

the interceptor matches the request against administration rules, which preferably

include printing attributes; page 6, paragraph [0107]).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Goodman (US 2003/0009672) in view of Wardell et al. (US 2003/0137696).

Regarding claim 6, Goodman '672 discloses a print device, wherein

said print job contains print contents of plural pages;

said inclusive attribute information (an internal format, page 6, paragraph [0102])

contains print conditions for respective pages of said print job (i.e., print server 160

enables the user to select print options, for example, printer, page orientation and page

range, and logs the user's selection; page 4, paragraph [0063], fig. 3B);

said attribute interpretation module (Mirage Server Software 155, fig. 2A) sets

the print conditions of the respective pages based on said inclusive attribute information

(i.e., a print control processor for obtaining print information specific to the original

document; page 2, paragraph [0016]).

Goodman '672 does not disclose a print device, wherein

said print job contains print contents of plural pages;

However, the above-mentioned claimed limitation is well known in the art as evidenced by Wardell '696. In particular, Wardell '696 teaches a print device, wherein

said print job contains print contents of plural pages (i.e., pages are indicated; page 4, paragraph [0048], fig. 7B);

In view of the above, having the system of Goodman '672 and then given the well-established teaching of Wardell '696, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Goodman '672 as taught by Wardell '696, since Wardell '696 stated on page 1, paragraph [0002] that such a modification would improve the throughput in rendering impositioned documents.

Regarding claim 7, Goodman '672 discloses a print device, wherein

said inclusive attribute information (an internal format, page 6, paragraph [0102]) contains print conditions of said print job (i.e., print server 160 enables the user to select print options, for example, printer, page orientation and page range, and logs the user's selection; page 4, paragraph [0063], fig. 3B);

said attribute interpretation module (Mirage Server Software 155, fig. 2A) includes a printability output module that makes a decision on printability based on said inclusive attribute information (i.e., a print control processor for obtaining print information specific to the original document; page 2, paragraph [0016]) and outputs a

result of the decision (i.e., if the document is stored in an unsupported format, then

preferably an HTML rendition is printed instead; page 4, paragraph [0063]).

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Tsuchitoi (US 6,831,753) discloses printing apparatus, print control method, and

recording medium storing print control program therein.

Kato (US 2005/0047843) discloses image forming system.

Sugiura et al. (US 2002/0080391) discloses print control method, a print server, a

client and a recording medium in a network environment.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Allen H. Nguyen whose telephone number is 571-270-

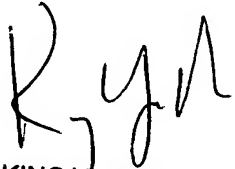1229. The examiner can normally be reached on M-F from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, King Poon can be reached on (571)-272-7440. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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KING Y. POON
PRIMARY EXAMINER